UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/782,850 | 02/14/2001 | Steven Mark Gebert | 8185P010 | 9299 |

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| EXAMINER |
|---|
| CAMPBELL, JOSHUA D |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/782,850 | GEBERT ET AL. |
| | Examiner | Art Unit | |
| | JOSHUA D. CAMPBELL | 2178 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>20 May 2008</u>.
2a) ☐ This action is **FINAL**.     2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>49-87</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>49-87</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1.      This action is responsive to communications: Request for continued examination
filed on 05/20/2008.

2.      Claims 49-87 are pending in this case.  Claims 49, 62, and 75 are independent
claims.  Claims 1-48 have been cancelled.  Claims 49-87 have been newly added.

3.      A request for continued examination under 37 CFR 1.114 was filed in this
application after a decision by the Board of Patent Appeals and Interferences, but
before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or
the commencement of a civil action.  Since this application is eligible for continued
examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been
timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution
in this application has been reopened pursuant to 37 CFR 1.114.  Applicant's
submission filed on May 20, 2008 has been entered.

### *Claim Rejections – Res Judicata*

4.      Claims 49-87 are rejected on the grounds of *Res Judicata* based on a prior
adjudication (see BPAI Decision mailed on January 23, 2008 affirming the examiner's
rejection of claims 1, 2, 4, 8-11, 14-16, 18, 22-25, 28-30, 32, 36-39, and 42-48) against
the inventor on patentably nondistinct claims involving the same issues.  The limitations
of claim 49 map to the patentably nondistinct limitations of previously rejected and
adjudicated claim 1 as follows:

| Previously rejected, appealed, and affirmed claim 1: | Newly filed claim 49 under 37 CFR 1.114: | Reasons limitations are patentably nondistinct: |
|---|---|---|
| A method for processing a source document in a structured document format including elements providing source content to render, wherein the source content comprises code that is rasterized into output, comprising: | A method for processing a source document in a structured document format including elements providing source content to render, wherein the source content comprises code that is rasterized into output, comprising: | Language repeated verbatim. |
| receiving the source document including the source content in a presentation language; | receiving the source document including the source content in a presentation language; | Language repeated verbatim. |
| receiving a layout data structure separate from the source document, providing formatting properties specifying a layout and format of the content output, wherein the layout data structure does not include source content; | receiving a layout data structure separate from the source document, providing formatting properties specifying a layout and format of the content output, wherein the layout data structure does not include source content; | Language repeated verbatim. |
| processing the source document and the layout data structure to determine formatting properties, including page divisions, for the content in the source document; | processing the source document and the layout data structure to determine formatting properties, including page divisions, for the content in the source document; | Language repeated verbatim. |
| generating **multiple page objects** wherein each page object includes the source content in the presentation language used in the source document and the determined formatting properties for one page, | generating **a first page object** including the source content in the presentation language used in the source document and formatting properties for one page; generating **a second page object** including the source content in the | Claim 1 discusses generating "multiple page objects" that meet a certain criteria, while claim 49 discusses generating both "a first page object" and "a second page object" which meet the same criteria as the "multiple page objects" in claim 1.  Clearly first and |

| | presentation language used in the source document and formatting properties for a second page, | second objects (two existing objects of specific criteria) are nondistinct from multiple objects (two or more objects of the same specific criteria). |
|---|---|---|
| wherein **at least one page object** has multiple content elements, and wherein the content elements include content to place on the pages; and | wherein **the first page object** includes a first set of content elements to place on the first page and **the second page object** includes a second set of content elements to place on the second page; and | Claim 1 discusses that "at least one page object" (1 or more) has multiple content elements to place on the page. Claim 49 discusses "the first page object" has a first set of content elements (multiple content elements) to place on the first page and "the second page object" has a second set of content elements (multiple content elements) to place on the second page.  The only difference in the claims is that claim 1 states that "at least one page object" meets specific criteria, while claim 49 states that a first and second object meet the same specific criteria.  However, it is clear that two objects of a specific criteria are patentably nondistinct from one or more objects (which by definition would include two) of the same specific criteria. |
| transmitting **the page objects** to a rasterizer to transform into renderable information capable of being generated by an output device. | transmitting **the first page object and the second page object** to a rasterizer to transform into renderable information capable of being generated by an output device. | Claim 1 discusses transmitting "the page objects" to a rasterizer, claim 49 discusses transmitting "the first page object and the second page object" to a rasterizer.  Again, clearly |

| | | first and second objects (two existing objects of specific criteria) are nondistinct from the page objects (two or more objects of the same specific criteria). |
|---|---|---|

Independent claims 62 and 75 are substantially similar to claim 49, and are considered to be patentably nondistinct of claims 15 and 29 of the previously appealed claims for the same reasons has claim 49 when compared to claim 1 of the previously appealed claims.

Dependent claims 50-61 are considered to be patentably nondistinct of claims 2, 4-11, 14, 43, and 44 of the previously appealed claims due to the fact that they recite the language of the previously appealed claims verbatim.

Dependent claims 62-74 are considered to be patentably nondistinct of claims 16, 18-25, 28, 45, and 46 of the previously appealed claims due to the fact that they recite the language of the previously appealed claims verbatim.

Dependent claims 76-87 are considered to be patentably nondistinct of claims 30, 32-39, 42, 47 and 48 of the previously appealed claims due to the fact that they recite the language of the previously appealed claims verbatim.

Thus, all of the currently pending claims as filed are rejected on the grounds of *Res Judicata* based on a prior adjudication against the inventor on patentably nondistinct claims involving the same issues, in effect barring the examiner from issuing these claims.

### Claim Rejections - 35 USC § 101

5.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 75-87 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are non-statutory for at least the reason that they are not properly embodied so as to be executable (i.e. stored on a computer readable storage medium which does not include a carrier wave or other form of transmission medium). The examiner recommends amending the claims in order to clarify that the article of manufacture consists of a computer readable storage medium which does not include a carrier wave or other form of transmission medium. The examiner notes that support for any amendment in order to overcome this rejection must have proper support in the specification. Proper correction is required.

### Claim Rejections - 35 USC § 103

6.      The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7.      Claims 49-56, 60-69, 73-81 and 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adler et al. (hereinafter Adler, Extensible Stylesheet Language (XSL) Version 1.0, published on October 18, 2000) in view of Saito et al. (hereinafter Saito, US Patent Number 5,323,312, issued on June 21, 1994).

**Regarding independent claim 49,** Adler discloses a method in which a source document including source content is received in XML (pages 17-18, section 1.1

Processing a Stylesheet). Then, a layout data structure (XSL stylesheet) which

provides formatting properties and is separate from the source document and does not

contain source content is received (pages 17-18, section 1.1 Processing a Stylesheet).

The two documents are processed together and to determine formatting, including page

divisions, of the source content (pages 20-21, Section 1.1.2 Formatting and pages 25-

27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout

Model). Adler also discloses a method in which multiple page objects are generated by

filling the XML content into "containers", each of the objects containing the content and

the information required to format the content, at which point the "containers" are

rasterized into page instances which are capable of being generated by an output

device (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging

and Scrolling and Section 1.2.3 An Extended Page Layout Model). Adler discloses that

the page objects include the content that is to be placed on the pages, Adler does not

explicitly state that the content consists of multiple content elements. However, Saito

discloses that it was well known in the art that a structured document could consist of

two parts a layout structure and a logical structure (source content), and when filling the

page objects defined by the layout structure more than one content object from the

logical structure could be used, thus allowing more than one content object to exist

within each page object (column 1, lines 31-57 of Saito). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to have used the

method of Adler with the well-known material disclosed by Saito because it would have

allowed the space in visible pages to be used completely by filling page objects with more than content object where it was warranted.

     **Regarding dependent claims 50,** Adler discloses a method in which page divisions may be presented in XSL-FO, which is a device independent language (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model).

     **Regarding dependent claim 51,** Adler discloses a method in which a page description language is used (pages 17-18, section 1.1 Processing a Stylesheet).

     **Regarding dependent claim 52,** Adler discloses a method in which the source document does not indicate page divisions (pages 17-18, section 1.1 Processing a Stylesheet).

     **Regarding dependent claims 53 and 54,** Adler does not explicitly disclose that a page object is filled with content objects until there is no more space, then the next page element is filled with the sequential content objects, or that page sequence elements exist in which the content is accessed in sequence and added to the page objects accordingly.  However, Saito discloses that it was well known in the art that a structured document could consist of two parts a layout structure and a logical structure (source content in the logical page viewing sequence), and when filling the page objects defined by the layout structure more than one content object from the logical structure could be used per page until a page is full at which point the next page object is filled with content and so forth (column 1, lines 31-57 of Saito).  It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the

method of Adler with the well-known material disclosed by Saito because it would have allowed the space in visible pages to be used completely by filling page objects before moving on to filling the next sequential page object.

   **Regarding dependent claims 55 and 56,** Adler also discloses a method in which the source document (XML) and the result document (XSL-FO) may be different formats, and the result document is formatted based on the layout data structure (XSL) (pages 17-18, section 1.1 Processing a Stylesheet and pages 20-21, Section 1.1.2 Formatting).  Adler also discloses a method in which multiple page objects are generated by filling the XML content into "containers", each of the objects containing the content and the information required to format the content, at which point the "containers" are rasterized into page instances which are capable of being generated by an output device (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model).

   **Regarding dependent claims 60 and 61,** Adler discloses a method in which page divisions may be presented in XSL-FO, which is a device independent language (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section 1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model).

   **Regarding independent claim 62 and dependent claims 63-69, 73 and 74,** the claims incorporate substantially similar subject matter as claims 49-56, 60, and 61. Thus, the claims are rejected along the same rationale as claims 49-56, 60, and 61.

**Regarding independent claim 75 and dependent claims 76-81 and 85-87,** the

claims incorporate substantially similar subject matter as claims 49-56, 60, and 61.

Thus, the claims are rejected along the same rationale as claims 49-56, 60, and 61.


8.      Claims 57, 59, 70, 72, 82, and 84 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Adler et al. (hereinafter Adler, Extensible Stylesheet Language (XSL)

Version 1.0, published on October 18, 2000) in view of Saito et al. (hereinafter Saito, US

Patent Number 5,323,312, issued on June 21, 1994) as applied to claims 55, 68, and 80

above, and further in view of Barry et al. (hereinafter Barry, US Patent Number

6,606,165, filed on January 8, 1999).

**Regarding dependent claim 57, 59, 70, 72, 82, and 84,** Adler does not disclose

page objects which are in a third presentation language which is a page description

language.  However, Barry discloses a method in which a document is split into multiple

page objects that contain the source content and formatting for one page in a different

page description language (image bit-map) (column 1, line 24- column 3, line 11 of

Barry).  It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have combined the method of Adler with the method of Barry

because it would have simplified the use of an output device to render a multi-paged

document.


9.      Claims 58, 71, and 83 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Adler et al. (hereinafter Adler, Extensible Stylesheet Language (XSL)

Version 1.0, published on October 18, 2000) in view of Saito et al. (hereinafter Saito, US

Patent Number 5,323,312, issued on June 21, 1994) further in view of Barry et al.

(hereinafter Barry, US Patent Number 6,606,165, filed on January 8, 1999) as applied to

claims 57, 70, and 82 above, and further in view of Sall (as found in the IDS - FOP:

Formatting Object to PDF Translator (James Tauber, published in 1999).

　　　　**Regarding dependent claims 58, 71, and 83,** Adler also discloses a method in

which the source document (XML) and the result document (XSL-FO) may be different

formats, and the result document is formatted based on the layout data structure (XSL)

(pages 17-18, section 1.1 Processing a Stylesheet and pages 20-21, Section 1.1.2

Formatting).  Adler also discloses a method in which multiple page objects are

generated by filling the XML content into "containers", each of the objects containing the

content and the information required to format the content, at which point the

"containers" are rasterized into page instances which are capable of being generated by

an output device (pages 20-21, Section 1.1.2 Formatting and pages 25-27, Section

1.2.1 Paging and Scrolling and Section 1.2.3 An Extended Page Layout Model).  Adler

does not disclose a method in which the language of the page objects is MO:DCA, a

common presentation imaging language.  However, Sall discloses a method in which an

XML is converted to XSL-FO based on an XSL stylesheet, then based on XSL-FO

convert the document to a PDF (pages 1-2 of Sall), which as defined in 1998 by

McCalpin (page 3 of "Traditional Electronic Printing on the Internet") as being an

common analogous presentation language to MO:DCA.  It would have been obvious to

one of ordinary skill in the art at the time the invention was made to have combined

Adler with methods taught by Sall because this method was noted to be a potential

replacement for typical desktop published due to formatting advantages.


### Response to Arguments

10.    Applicant's arguments with respect to claims 49-87 have been considered but are

moot in view of the rejection under Res Judicata, the issues that are being argued have

been previously adjudicated (see BPAI Decision mailed on January 23, 2008 affirming

the examiner's rejection).


### Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is

(571)272-4133.  The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on (571) 272-4124.  The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
September 24, 2008